

**III. Remarks**

To highlight the distinction of the above referenced invention over the prior art as interpreted by the Examiner in the Office Action of September 22, 2003, Paper No.8, the specification and claims were amended as set forth herein. Independent Claims 1, 7, 12 and 17 were amended to more clearly define the subject matter of the invention and to place all of the claims remaining in the application in condition for allowance.

The specification was amended herein to correct matters of a grammatical and typographical nature. No new matter was presented and such amendments are deemed unobjectionable. Entry thereof is respectfully requested.

In the above reference Office Action, the Examiner rejected Claims 1-3, 5, 7, 8, 10, 12, 13, 15 and 17 under 35 U.S.C. §112, first paragraph as failing to comply with enabling requirement. It is the Examiner's opinion that the claims as earlier submitted contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most merely connected, to make and/or use the invention. The Examiner considered the inclusion in the independent claims of the phrase "final folded flat state" to have no support in the specification.

The undersigned specifically traverses the above rejection for the simple reason that the specification provides an ample description in such a way as to enable a person skilled in the art to which it pertains to make and use the invention as earlier claimed. For example, the background adequately sets forth the

problem with the prior art being the fact that there is no optimized way to transport portable toilets. Thereafter, the brief summary of the invention again, clearly disclosed an arrangement of a portable toilet shelter which presents a more compact, more stackable and easier to assemble and disassemble portable toilet unit than any prior art shelter and is therefore much more cost effective. Further, the detailed description of the preferred embodiment at page 10, lines 14-24 as well as page 11, lines 1-3 in conjunction with the disclosures of Figures 8 and 9, very clearly disclosed to a person skilled in the art the flat state of the walls and clearly discloses that the walls overlay or are superimposed in view of the definition set forth on page 11, lines 5-8 for the word overlay. Accordingly, the specification sets forth adequate enablement to a person skilled in the art or to support the claims as earlier claimed. However, to clearly describe the invention, the objected to language has been removed and replaced herein by the word "stackable" instead of "final". There is certainly clear and adequate support throughout the specification to a person skilled in the art as to the stackability of the folded portable toilet shelter and the advantages derived therefrom. Accordingly, it is respectfully requested that in view of the amendment to the independent claims herein, that the rejection under 35 U.S.C. §112, first paragraph, although improper with respect to earlier language, now be withdrawn for the simple reason that the claims as set forth, as amended, more clearly set forth the invention which is adequately supported by the description in the specification to a person skilled in the art.

In the above referenced action, the Examiner rejected Claims 1, 2, 5, 7, 8, 10, 12, 13, 15, and 17 under 35 U.S.C. §103(a) as being unpatentable over teachings of Dahl, U.S. Patent No. 2,820,256 in view of the teachings of Tegg et al., U.S. Patent No. 4,744,111. The Examiner further rejected Claims 3, 8 and 13 under 35 U.S.C. §103(a) as being obvious and unpatentable over prior art as applied to Claim 1 and further in view of the teachings of Braxton '836.

Applicant's attorney respectfully traverses each of the 35 U.S.C. §103 rejections set forth herein in view of the claims as currently amended and for the reason that Applicant's invention is not an obvious improvement over the prior art.

With respect to the rejections under 35 U.S.C. §103, it is noted in MPEP Section 706 that the standard of patentability to be followed in the examination of a patent application is that which was enunciated by the Supreme Court in *Graham v. John Deere*, 148 USPQ 459 (1966), where the Court stated:

"Under Section 103, the scope and the content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

Accordingly, to establish a prima facie case of obviousness, the Patent Office must; (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art provides a motivating suggestion, inference or

implication to make the modifications proposed in step (2) above. *In re Jones*, 21 USPQ2d 1941(Fed. Cir. 1992).

The mere fact that the prior art may be modified by the Examiner does not make the modification obvious unless the prior art suggests the desirability for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). In the present case, the Examiner has failed to make a proper prima facie showing of obviousness since the Examiner has failed to show how the prior art suggests the desirability of the proposed modification.

Once again, as in the earlier responsive amendment, it is important to point out that the Office Action does not present a complete obviousness rejection. According to the requirements of MPEP §706.02(j), a complete obviousness rejection requires an Office Action to set forth the following:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;

(B) the difference or differences in the claim over the applied references;

(C) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

Here, the Office Action once again, fails to set forth the motivation to make the proposed modification and, therefore, the Office Action does not adequately communicate the basis for the obviousness rejection made by the Examiner such that the Applicant has not be given a full and fair opportunity to develop an appropriate reply. As such, it is respectfully asserted that the Office Action does not clearly and fully explain the rationale for the obviousness rejection other than to conclude that the motivation is somehow created by the fact that identical prior art references are selected by the Examiner and combined to reject the claims. Clearly this is improper and accordingly, it is respectfully requested that the final status of this action be withdrawn since the Applicant has not been entitled to a full and clear explanation for the obviousness rejections.

The Office Action fails to set forth a *prima facie* case of obviousness. As set forth above, in order to establish a *prima facie* case of obviousness according to MPEP §706.02(j), the cited references must teach or suggest all of Applicant's claim limitations, and there must be some suggestion or motivation to modify a reference or to combine teachings of each of the references.

The unobviousness of the present invention over the cited reference will become clear upon considering each of the problems that the prior art is directed to and the teachings each proposes in order to solve this problem as follows:

Dahl is directed to the general problem of the lack of transportability of temporary toilet shelters. To solve this problem Dahl proposes a light weight enclosure, which is of rugged constructions and may be readily erected and collapsed

into compact portable form for transportation from one site to another. The structure consists of four upright side walls each including a pair of wall sections on opposite sides of a central dividing line that extend transversely around the enclosure. The side walls are foldable relative to each other along their vertical edges and the wall sections are foldable along the central dividing line to form a compact stack of eight wall sections. Such a stack is light enough and small enough to be carried by a passenger automobile and therefore may serve for family use as well as industrial use. Two adjacent sections of two adjacent side walls are detachable with respect to one another and are respectively at opposite sides of the stack and are interconnected by a double hinge of a width sufficient to extend across the thickness of six intermediate wall sections of the stack. The remaining wall sections are interconnected by transverse hinges. In the preferred practice of the invention the enclosure has a doorway on one of its four sides and a permanently hinged door for the doorway which is made in two sections lying on opposite sides of the traverse dividing line to permit the desired collapse of the structure into the eight layer stack. Dahl teaches that it is highly desirable to have all eight of the wall sections interconnected to provide insurance against any section becoming separated, misplaced or lost. Such interconnection is also desirable to maintain the desired relationship among the various sections to prevent confusion that may be caused by one section being inadvertently moved out of its normal place in the eight-section assembly. In the final step of the folding arrangement, as shown in Figure 3, the wall sections are folded down on itself using a hinge trip 40 thereby forming a stack of eight of the wall sections. It is apparent in

this final folded state of the structure that double inch strip 40 unifies a stack since it cooperates with the wall sections 26 and 32 enclosed the remaining six wall sections.

Tegg et al., U.S. Patent No. 4,744,111 is directed to problems associated with portable toilet structures for outdoor concerts, athletic events, and the like. These portable units are cumbersome and must be transported in the assembled condition thereby limited the number of units that may be transported by a carrier. Prior art knock down units have been proposed to permit a larger number of units to be transported on each carrier but disassembly and reassembly of these units is usually a time consuming operation. To solve this problem, Tegg et al. teaches a portable knock down toilet structure, which is readily assembleable into a complete unit, simple and inexpensive. The vertical walls are provided with slots in the edges thereof and U-shaped clamping members having pins which engage in the slots are utilized so that each clamping member releasably clamps the edges of the pair of adjacent walls. Further, the lower edges of portions of the vertical walls are provided with slots for quick releasable engagement with clips secured to the base to permit ready attachment and detachment of vertical walls to the base. The top wall is releaseably secured to the vertical walls by cam locks mounted on the vertical walls and engageable with the slots in the top wall. With this arrangement, a single operator may readily assemble and disassemble a plurality of the toilet structures only in a matter of minutes. Because of the construction of various components, the components may be stacked on an carrier vehicle to permit the transport of a large number of units, while minimizing the space requirements. For example, the side

walls and rear walls may be placed in a single stack, and the front walls with the attached doors may be placed in another. The bases may be arranged in stack relation, and the holding tank and other units may be arranged together. Damage components such as a damaged vertical wall may be readily replaced without requiring replacement of the entire unit.

Applicant's invention is directed to problems associated with his earlier portable toilet shelter, which is significantly more cumbersome to stack and fold as is the collapsible enclosure as thought in the Dahl reference. To solve this problem, Applicant teaches a portable toilet shelter including the loop enclosure that is mountable to a base, and is adapted to receive a roof. The loop enclosure includes opposed end walls each having opposed edges. Opposed side walls are positioned between the opposed end walls, with each of the side walls having opposed edges. Flexible hinges connect the edges of the side walls to respective adjacent edges of the end walls to complete the loop enclosure. The loop enclosure is lifted away from the base and placed on its side permitting it to automatically fold flat on the ground, as depicted in Figures 8 and 9 of the application. When the loop enclosure is placed on its side and permitted to collapse, the front and back end walls fold relatively towards their respective side walls. In other words, the walls collapse towards one another such that the inside surface of the front end wall overlays the one of inside surfaces of one of the side walls, while the inside surface of the back end wall overlays the other of the inside surfaces of the side walls. Additionally and alternatively, according the collapsed portable toilet shelter the roof and floor can be



collapsed and folded together with the loop enclosure. Once the loop enclosure is set aside or loaded on a truck in its stackable condition, the empty toilet unit is removed from the base and loaded to a truck and the base is then lifted from the ground and loaded to the truck. Accordingly, the compact collapsed loop enclosure can be stacked in any convenient manner to maximize the number of units transportable by a truck.

The differences between Applicant's invention and the prior art references cited by the Examiner in the rejection under 35 U.S.C. §103 are quite clear. The solutions taught by each of the references are directed to problems somewhat different than that described in Applicant's invention. For example, Dahl is directed to providing a light weight enclosure of the type which is simple and may be readily erected and also collapsed into a compact portable form by a single individual for transportation from one site to another. Tegg et al. is directed to problems associated with portable chemical toilet structures of the type, which are transported in an assembled condition thereby limiting the number of units, which may be transported by a carrier. If, as the Examiner suggests, the teachings of Dahl are combined with Tegg et al. in an attempt to obviate Applicant's invention, it is clear from the teachings set forth in Tegg et al. that the suggested combination would certainly not result in Applicant's invention for the simple reason that Tegg et al. suggests the use of multiple piece toilet shelters which are assembled on site while Dahl teaches the use of a readily collapsible and erectable compact portable units which maybe erected by a single individual. Accordingly, the objects of each

of the patents are contrary to each other and therefore there is absolutely no motivation, suggestion or inference whatsoever to combine the teachings of these two references in an attempt to obviate Applicant's invention. Further, although the Examiner alleges that Dahl suggests the claimed invention of Applicant's amended independent claims, except for a base and a roof, the Applicant respectfully disagrees with the allegations of the Examiner for the simple reason that there are significant functional and structural differences between Applicant's invention and the teachings of Dahl or the teachings of '111 patent of Tegg et al., or any combination thereof. Both cited references fail to disclose, teach or suggest a loop enclosure collapsed to a stackable flat state having a thickness of about two of the walls thereof. Rather, the Dahl '256 patent teaches that the enclosure collapses to a final folded flat state having thickness of about eight of the walls thereof (Figure 4). Similarly the Dahl reference teaches the use of a double hinge 40, 55, the prevents the enclosure from having a final folded flat state, much less having a thickness of about two walls of the loop enclosure. The double hinge 40, 55 projects upwardly and thus does not enable the enclosure to fold to a flat state having a thickness of about two of the walls thereof, and thereby prevents multiple enclosures from being stacked flat atop one another. This is simply because the Dahl reference fails to teach an enclosure which is meant to fold flat to a thickness of about two walls thereof. Rather, Dahl teaches use of the double hinge 40, 55 to enable the Dahl enclosure to fold to a flat state having a thickness of eight of the wall sections (Column 3, lines 1-3). Accordingly, it is clear, that the Dahl reference in and of

itself teaches contrary or opposite of Applicant's teachings from the standpoint that the Dahl reference invention results in a thickness of eight fold of all sections while Applicant's invention results in a thickness of two folded stackable loop enclosure. The teachings of Tegg et al. add absolutely nothing to the teachings of Dahl in order to, in anyway whatsoever suggest, imply, infer or motivate to a person skilled in the art to teach Applicant's invention. In fact, in consideration of the Tegg et al. reference, which teaches away or opposite to Applicant's invention, it is clear that if any of the cited references teach away from the suggested combination, as set forth in the claims, the claimed invention is distinguishable over the combination of cited references (MPEP §2145).

Thus, even if the combination as suggested by the Examiner is justified, Applicant's claims set forth unobvious features over the proposed combination. Accordingly, the combination would necessary constitute claimed subject matter that is different and patentably distinct over the teachings of the prior art references.

One of ordinary skill in the art would have no basis for combining the teachings of Dahl and Tegg et al. reference in order to attempt to obviate Applicant's invention, because there is no suggestion or motivation in this prior art to do so. It is well settled patent law that a sustainable obviousness rejection requires some teachings, suggestions or motivation to combine the references in order to obviate Applicant's invention. Here, the Examiner fails to completely set forth any prima facie showing of obviousness since the Office Action does not provide any

suggestion for the desirability for the proposed combination, other than “the fact that identical art devices was shown as set forth...meets the motivation for the ordinary artisan.” (Office Action breaching pages 3 and 4) The fact that both references disclose a portable toilet is not, by itself, sufficient to selectively substitute parts of one reference for part of another to meet Applicant’s novel invention as claimed. Moreover, the Office Action does not set forth any principle with specific understanding within the level of ordinary skill in the art that would have motivated a skilled artisan to even attempt to combine these cited references. The complete assertion that it would have been prima facie obviousness because “the fact that the art teaches identical environments is the primary motivating factor here and does not meet the 103 provisions as applied to the ordinary artisan.”, does not amount to the required explanation as to why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. Applicant respectfully submit that the Office Action’s lack of indication anywhere in the record of the finding in the cited references of the suggestion for the desirability of the proposed combination, militates against an obviousness rejection of Applicant’s invention as claimed.

Regardless of the lack of the proper suggestion in the Office Action, the cited references themselves contain no suggestion whatsoever for combining the references that teach the invention as claimed according to Applicant’s disclosure. In other words, there is nothing in the reference alone or together that suggests the claimed invention as a solution to the problem of a stackable enclosure and, in fact,

it is indeed Applicant's invention to invent a simple solution to such problem. Not a single applied reference mentions the problems associated with enclosures that are not optimized for stackability. Significantly, Applicant specifically identifies the four-wall thickness of the collapsed structure of his own earlier patent as a problem to be solved. The Dahl enclosure teaches a collapsed enclosure having a thickness of eight walls- twice as great as that of the Applicant's earlier patent. Therefore, absent the recognition of the problem identified by the Applicant, it would be impossible for its solution to be obvious to anyone, and the cited references cannot possibly suggest, singularly or in combination, a solution as novel as Applicant's invention.

The Office Action does, however, conclusively set forth that it would have been obvious to combine the references. But, the mere fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to withstand the issue of prima facie case of obviousness. (See MPEP 2143.01) Similarly, just because one of ordinary skill in the art could rearrange parts of a reference device to meet the terms of the claims is not, by itself, sufficient to support a finding of obviousness. The cited references must provide a motivation, without the benefit of reading Applicant's disclosure, to make the change in the reference device. (See MPEP §2144.04). Applicant respectfully requests, if the claims are again rejected, upon any combination of references, that the Office Action include, in accordance with MPEP §706.02, a specific and substantiated factual basis to support the conclusion that it would have been obvious to combine the references.

In view of a lack of a suggestion from the Office Action and from the cited references, a person of ordinary skill in the art would not seek to combine these references cited in the Office Action to produce the results that Applicant invention teaches. It is only through Applicant own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a portable toilet shelter having a base, a loop enclosure circumscribing the base, wherein the loop enclosure is collapsible to a stackable, folded state having a thickness of about two of the walls thereof. In other words, but for Applicant's disclosure, there is no teaching, suggestion, or motivation whatsoever to combine the teachings of Dahl and the teachings of the Tegg et al. patent in any way in order to obviate Applicant's invention. Accordingly, Applicant respectfully asserts that the Office Action is an example of hindsight reconstruction in an attempt to obviate Applicant invention after having the benefit of reading Applicant disclosure. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the cited references to deprecate the claimed invention.

Applicant invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of record in this application. When viewed singularly or collectively, none of the cited references disclose, teach, or even suggest a portable toilet shelter having a base, a loop enclosure circumscribing the base, and the loop enclosure being collapsible to a stackable folded state having a thickness of about two of the walls thereof. Thus, independent Claims 1, 7, 12, and 17 are not rendered obvious by any of the cited

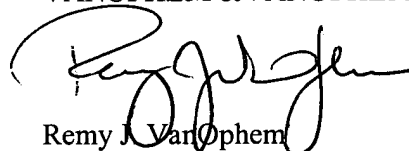
references. Under principles of claim dependency and for at least the reasons stated above, Dahl and the Tegg et al. patent do not render obvious any of the dependent claims as well. Therefore, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

In view of the indication that this is a final Action, every attempt has been made to place all of the claims remaining in the application in condition for allowance. Should the Examiner for any reason not be convinced of the patentability of the claims herein it is respectfully requested that for purposes of appeal, that this response be entered in order to complete the record for appeal purposes.

If the Examiner has any questions with respect to any matter now of record, Applicant's attorney may be reached at (586) 739-7445.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.



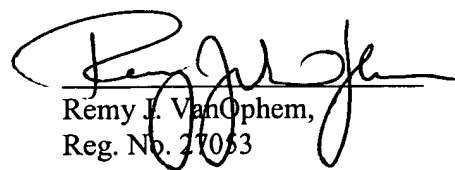
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